

## REMARKS

### I. Introduction

In view of the above amendments and the following remarks, reconsideration of the rejections contained in the Office Action of April 22, 2009 is respectfully requested.

By this amendment, claim 9 has been amended and claims 16-23 have been added.

Claims 1-23 are now pending in the application. No new matter has been added by these amendments.

### II. Prior Art Rejections

Currently, claims 1-5, 7-13, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nihei et al. (US 5,570,609) in view of Terada (EP 1 085 389) and claims 6 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nihei et al. in view of Terada and further in view of Cordell et al. (US 6,996,456).

Claims 1 and 9 are patentable over Nihei et al., Terada, and Cordell et al., whether taken alone or in combination, for the following reasons. Each of claims 1 and 9 require a method of adjusting an origin of an industrial robot comprising, in part, providing an industrial robot which includes a first member having an accommodation hole, a positioning member attached to the first member and being positionable in the accommodation hole, a second member having a contact point being operable to contact the positioning member, wherein said positioning member has a first position in which said positioning member protrudes from said first member such that the positioning member is operable to contact the contact point, and a second position in which said positioning member is disposed in the accommodation hole and is not operable to contact the contact point.

The Office Action acknowledges that the Nihei et al. reference does not disclose an accommodation hole as required by claims 1 and 9. (See Office Action at page 4). The Terada and Cordell et al. references are cited for alleged disclosures unrelated to the accommodation hole required by claims 1 and 9; no assertion is made in the Office Action that either of the Terada and Cordell et al. references teach the accommodation hole required by claim 9. Instead, the Office Action states that “it would have been obvious to one of ordinary skill in the art...that a storage location is needed for a positioning member that is removable and would be needed repeatedly. It would have been obvious to try an accommodation hole as one of a finite number of alternatives that could be identified, each a predictable solution with a reasonable expectation of keeping a needed part available for utilization. Further, since Nihei suggests that the reference mechanism could be incorporated in multiple joints of an industrial robot, it would be obvious to provide an accommodation hole to secure a single positioning pin that could be used to calibrate any of the joints.” (See Office Action at page 4, lines 6-14, emphasis added.) This obviousness rationale asserts that one of ordinary skill in the art (1) would have independently recognized the problem which Applicants have recognized, and (2) would have solved the problem in precisely the same way which Applicants have solved it despite their being no identification in the prior art of how to do so.

“To reject a claim based on [an obvious to try] rationale...Office personnel must articulate the following: (1) a finding that at the time of the invention, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem; (2) a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem...” MPEP 2143 (emphasis added). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements;

instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (U.S. 2007). "[I]n considering the question of obviousness, we must view the prior art from the point in time just prior to when the patented device was made. Many things may seem obvious after they have been made, and for this reason courts should guard against slipping into use of hindsight. We must be careful to 'view the prior art without reading into that art the teachings of appellant's invention.'" *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (6th Cir. 1964).

As quoted above, the MPEP establishes that in order for an "obvious to try" rationale to support a conclusion of obviousness, the Examiner must first find that there was a recognized problem in the art at the time the invention was made. In the instant case, the Examiner makes only the conclusory statement that "it would have been obvious to one of ordinary skill in the art...that a storage location is needed." There is no prior art document or other support cited which establishes that the problem was recognized in the art at the time the invention was made, nor even the assertion that the problem was recognized in the art at the time the invention was made. Instead, the Examiner merely asserts that it would have been obvious to recognize that a storage location is needed, *i.e.* a person skilled in the art could have independently recognized the problem. Because the obvious to try rationale set forth in the Office Action fails to prove or even assert that there was a recognized problem in the art at the time the invention was made, that obviousness rationale is improper.

The MPEP further establishes that a proper "obvious to try" obviousness rationale must include the finding that there had been a finite number of identified solutions to the recognized problem. In the instant case, the Office Action makes only the statement that "an

accommodation hole [is] one of a finite number of alternatives that *could be* identified.” This assertion is both legally incorrect and factually incorrect. The legal standard for an obvious to try rationale is whether the finite number of solutions *had been* identified, not whether they *could be* identified. Because the prior art does not identify the solution which Applicants have invented, an obvious to try rationale cannot support a conclusion of obviousness in the present case. Moreover, notwithstanding the fact that the legal standard has not been satisfied in the present case, it is factually incorrect to state that there are a finite number of places to store the positioning member (24) of the Nihei et al. reference; the number of places in which a small component part could be stored in the physical world is literally infinite. Because the obvious to try rationale set forth in the Office Action fails to prove or even assert that there had been a finite number of identified solutions at the time the invention was made, that obviousness rationale is improper.

Lastly, page 4 of the Office Action states that “since Nihei suggests that the reference mechanism could be incorporated in multiple joints of an industrial robot, it would be obvious to provide an accommodation hole to secure a single positioning pin that could be used to calibrate any of the joints.” This statement fails to cure the above-discussed deficiencies in the obvious to try rationale set forth in the Office Action; it fails to establish a problem which was recognized at the time the invention was made, and it likewise fails to establish an identification of the solution which Applicants have invented.

It is thus submitted that the invention of the present application, as defined in claims 1 and 9, is not anticipated nor rendered obvious by the prior art, and yields significant advantages over the prior art. Allowance is respectfully requested.

Claims 2-8 and 16-23 depend, directly or indirectly, from claim 1 and are thus allowable

for at least the reasons set forth above in support of claim 1. Claims 10-15 depend, directly or indirectly, from claim 9 and are thus allowable for at least the reasons set forth above in support of claim 9.

In view of the foregoing amendments and remarks, inasmuch as all of the outstanding issues have been addressed, Applicants respectfully submit that the present application is now in condition for allowance, and action to such effect is earnestly solicited. Should any issues remain after consideration of the response, however, the Examiner is invited to telephone the undersigned at the Examiner's convenience.

*The Commissioner is authorized to charge any deficiency or to credit any overpayment associated with this communication to Deposit Account No. 23-0975, with the EXCEPTION of deficiencies in fees for multiple dependent claims in new applications.*

Respectfully submitted,

Tatsuya IKEDA et al.

/Andrew D.  
By: St.Clair/

Digitally signed by /Andrew D. St.Clair/  
DN: cn=/Andrew D. St.Clair/, o, ou,  
email=astclair@wenderoth.com, c=US  
Date: 2009.07.22 17:08:54 -04'00'

Andrew D. St.Clair  
Registration No. 58,739  
Attorney for Applicants

ADS/rgf  
Washington, D.C. 20005-1503  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
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